UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND VINCENT ST. JOHN KILLICK

Appeal No. 2006-1072
Application No. 09/520,576

ON BRIEF

Before FRANKFORT, NAPPI, and FETTING, **Administrative Patent Judges.**
FETTING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 34-40, 42, 43, 46, 47 and 50-60, which are all of the claims pending in this application.

We REVERSE .

BACKGROUND

The appellant's invention relates to a system for analyzing consumer data. An understanding of the invention can be derived from a reading of exemplary claim 34, which is reproduced below.

> 34. A system for analyzing consumer data stored on a consumer storage device comprising:
>
> a terminal device;
>
> a consumer data acquisition device that stores consumer data; and
>
> a computer program for analyzing consumer data wherein said computer program is at least in part remote from said terminal device, and
>
> a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device,
>
> wherein the terminal device is operable to extract at least a portion of the consumer data stored on the consumer data acquisition device for analysis by the computer program.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Gottlich et al. (Gottlich)	6,024,288	Feb. 15, 2000 (eff. filing Dec. 27, 1996)
Barnett et al. (Barnett)	6,321,208	Nov. 20, 2001 (filed Apr. 19, 1995)
Stevens	6,327,570	Dec. 04, 2001 (filed Nov. 06, 1998)

Unidentified Author, "What Grocers Want in Electronic Marketing Programs" ("What Grocers Want"), POS News, v.7, n.13, May 1991.

Claims 34-40, 42, 43, 46, 47 and 50-60 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stevens in view of "What Grocers Want" and Barnett.

Claims 34-40, 42, 43, 46, 47 and 50-60 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gottlich in view of "What Grocers Want" and Barnett.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (mailed May 5, 2005 and again on September 23, 2005) for the examiner's reasoning in support of the rejections, and to appellant's brief (filed March 21, 2005) and reply brief (filed July 8, 2005) and supplemental appeal brief (filed February 17, 2006) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim Construction

We initially note that nothing in the independent claims requires physical separation of the terminal from the consumer data acquisition device or separation of the terminal

from the collection center. The specification at page 9 further suggests that the consumer data acquisition device may physically incorporate the terminal.

We also note that both independent claims require that the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device. There are three potential interpretations of this limitation:

1. As an alternative limitation, i.e. a Markush group; or

2. As a set of two possible manifestations, each of which would arise in a different context; or

3. As a set of two possible manifestations, each of which may arise in a different or in the same context.

The specification and prosecution history make it clear that the third interpretation is the appropriate interpretation. The specification at p. 13 states that at step 206 of Fig. 2, **all or part of the data** for the consumer **is extracted** from the database. The specification elaborates on this in describing process step 404 in Fig. 4 at p. 16 in which the extraction instruction **may be specific** for a particular consumer or circumstance then existing **or a standing instruction** for extraction of purchasing data and preferences. The Appellant argues that this claim limitation permits selective extraction of data as dictated by a remote device, and that none of the recited references disclose, teach, or suggest that a collection center can dictate what information is selectively extracted

from a consumer device. [see Brief at pp. 7 and 13]. Therefore, this limitation is such that the collection center in the independent claims decides whether to extract all or to extract part, and if part, which part, of the data within each context.

Claims 34-40, 42, 43, 46, 47 and 50-60 rejected under 35 U.S.C. § 103 as being unpatentable over Stevens in view of "What Grocers Want" and Barnett.

The examiner argues that Stevens shows selective extraction of at least a portion of the data at col. 19, lines 1-40 and col. 10, lines 35-45 [See Answer at p. 3] The examiner argues that "What Grocers Want" pp. 1 and 2 teaches selective extraction of data where a terminal cannot extract all of the data and relies on this to show the motivation for modifying Stevens because it would have avoided gathering too much information. [See Answer at pp. 4, 9, 10]. The Examiner also argues that Barnett instructs a terminal to extract all of the data at col. 5 lines 27-35, col. 12 lines 30-36, Fig. 4a, col. 7 line 62 to col. 8 line 5, col. 8, lines 43-48 and col. 14 lines 16-19, and that Barnett discloses using different parts of data at col. 12 lines 37-50, from which the examiner concludes that Barnett provides a motivation to extract information of interest. [See Answer at pp. 5 and 13].

As noted above, the Appellant argues that Stevens does not disclose, teach, or suggest that a collection center can dictate what information is selectively extracted from a consumer device.

We note that none of the applied references are oriented toward database query techniques to show the specific database query techniques employed, but focus on the results of the queries and transmissions instead. Therefore, much of the examiner's arguments rely on inferences from the teachings in the references. In contrast, the Appellant's principle argument is precisely that none of the applied references teaches the query technique specifically claimed.

We now turn to each of the teachings the examiner argues to refute the principle argument by Appellant.

Stevens col. 19, lines 1-40 shows extraction of data to a store and to a medical provider. Stevens does not specify precisely which data is extracted in each context, but suggests the query would be limited to each context. While, as the examiner indicates, this might very well show selective extraction of some of the data, in this context there would never be extraction of all of the data, if only for medical data privacy reasons.

Stevens col. 10, lines 35-45 shows feeding rather than extraction of data to a store.

"What Grocers Want" pp. 1 and 2 teaches that retailers want control over what consumer data is collected and where that data goes and do not want more data than can be used, or to lose control over the data. While this may very well suggest, as the examiner argues, a motivation for being selective in what data is collected, it suggests nothing regarding the selective extraction of data after it has been collected.

Barnett col. 5 lines 27-35 shows extraction of all of the coupon data that a consumer has previously selected, and therefore does not show selective extraction by a collection center.

Barnett col. 12 lines 30-36 shows extraction of data from a database that is not at the site of the consumer as shown in Fig. 10.

Barnett Fig. 4a, col. 7 line 62 to col. 8 line 5 and col. 14 lines 16-19 show a consumer registration procedure in which all of the registration data is fed to a collection center rather than the collection center selectively extracting a portion of data from the consumer's device.

Barnett col. 8, lines 43-48 shows a message system in which a consumer sends an entire message to a collection center for a bulletin board rather than the bulletin board selectively extracting all or part of messages stored on the consumer's device.

Barnett does disclose using different parts of data at col. 12 lines 37-50 as argued by the examiner, but that data is at a central database rather than residing on the consumer devices.

None of the portions of any of the references applied show a collection center that can dictate what of all or some information is selectively extracted from a consumer device. Absent a showing of how the art meets the claim limitation, the examiner's arguments for combining the references are moot, for the examiner has failed to make a *prima facie* case by not showing how all of the claim limitations are met. The rejections

of the dependent claims must therefore also be absent a *prima facie* case of unpatentability for the same reason as the independent claims. The rejection of claims 34-40, 42, 43, 46, 47 and 50-60 under 35 U.S.C. § 103 as being unpatentable over Stevens in view of "What Grocers Want" and Barnett is therefore **not sustained**.

Claims 34-40, 42, 43, 46, 47 and 50-60 rejected under 35 U.S.C. § 103 as being unpatentable over Gottlich in view of "What Grocers Want" and Barnett.

The examiner argues that Gottlich shows selective extraction of at least a portion of the data at col. 11, line 50 to col. 12 line 15 and col. 12, line 50 to col. 13 line 15. [See Answer at p. 6] . The examiner argues that "What Grocers Want" teaches selective extraction of data where a terminal cannot extract all of the data and relies on this to show the motivation for modifying Gottlich because it would have avoided gathering too much information, and it would have freed up limited memory space on the consumer data acquisition device, presumably by erasure following the extraction, which the examiner argues is taught by Gottlich at col. 11, lines 60-65 and col. 13 lines 5-10. [See Answer at p. 6]. The Examiner also argues that Barnett instructs a terminal to extract all of the data at col. 5 lines 27-35 and col. 12 lines 30-36, and that Barnett discloses using different parts of data at col. 12 lines 37-50, from which the examiner concludes that Barnett provides a motivation to extract information of interest. [See Answer at p. 5].

As noted above, the Appellant argues that Gottlich does not disclose, teach, or suggest that a collection center can dictate what information is selectively extracted from a consumer device.

We note that none of the applied references are oriented toward database query techniques to show the specific database query techniques employed, but focus on the results of the queries and transmissions instead. Therefore, much of the examiner's arguments rely on inferences from the teachings in the reference. In contrast, the Appellant's principle argument is precisely that none of the applied references teaches the query technique specifically claimed.

We now turn to each of the teachings the examiner argues to refute the principle argument by Appellant.

Gottlich col. 11, line 50 to col. 12 line 15 shows batch uploading of data from a collection center to a database for analysis software to access the data. Gottlich teaches that the data in the collection center is retrieved from a consumer data acquisition device by a card reader, suggesting that all data is extracted from the consumer data acquisition device.

Gottlich col. 12, line 50 to col. 13 line 15 shows that the analysis software may selectively consider different portions of consumer data, but the data used by the analysis program is all of the data read from the consumer data acquisition device plus all additional data entered into a collection center by a consumer, and offers no suggestion that the data extracted from the consumer data acquisition device is selective and may be all or none.

Our analysis and conclusions regarding the applicability of "What Grocers Want" and Barnett, are the same as indicted in the first rejection of these claims above.

None of the portions of any of the references applied show a collection center that can dictate what of all or some information is selectively extracted from a consumer device. Absent showing how the art meets this claim limitation, the examiner's arguments for combining the references are moot, for the examiner has failed to make a *prima facie* case by not showing how all of the claim limitations are met. The rejections of the dependent claims must therefore also be absent a *prima facie* case of unpatentability for the same reason as the independent claims. The rejection of claims 34-40, 42, 43, 46, 47 and 50-60 under 35 U.S.C. § 103 as being unpatentable over Gottlich in view of "What Grocers Want" and Barnett is therefore **not sustained**.

CONCLUSION

To summarize, the decision of the examiner to reject claims 34-40, 42, 43, 46, 47 and 50-60 rejected as being unpatentable over Gottlich in view of "What Grocers Want" and Barnett under 35 U.S.C. § 103 or over Stevens in view of "What Grocers Want" and Barnett under 35 U.S.C. § 103 is **reversed**.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

ROBERT E. NAPPI
Administrative Patent Judge

ANTON W. FETTING
Administrative Patent Judge

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ANT/vsh

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